

REMARKS

By the above amendment, Claims 1-6, 9, 13-15, and 19-22 have been cancelled without prejudice or disclaimer. In addition, Claims 26-38 have been added. Thus, the claims in the case are 7, 8, 10-12, 16-18, and 23-38. Favorable action thereon is requested in light of the following comments. A paper authorizing payment of the fee for the one additional independent claim accompanies this response.

The suggested arrangement of the claims now in the case is 26-28, 7, 29, 8, 30, 10-12, 16-18, 31, 23, 24, 33, 25, and 34-38.

New Claims 26 and 30 is based, for example, on original Claims 1 and 9, respectively, and are directed to the subject matter set forth in original subsection C of Claims 1 and 9. Similarly, new Claims 32 and 34 are based on original Claim 19 to cover the methods set forth, for example, in original Claim 19. The other new claims are supported by the disclosure such as for example original claims in the case and the proportions as disclosed in paragraph 0025, the forms in which the 1,3-dibromo-5,5-dialkylhydantoin(s) is/are added to water, and the use of 1,3-dibromo-5,5-dimethylhydantoin or a mixture of 1,3-dibromo-5,5-dimethylhydantoin and 1,3-dibromo-5-ethyl-5-methylhydantoin as disclosed in paragraph 0020. The amendments to the dependent claims are largely for the purpose of updating the dependencies.

Applicants request reconsideration and withdrawal of the rejection of Claims 19-25 under 35 USC 112, second paragraph. The Action indicates that Claim 19 was seen as a method for preparing a drinking water, and thus new Claims 32 and 34 are directed to that aspect of original Claim 19. Thus, the rejection is deemed inapplicable to the claims now in the case. It is to be noted that original Claim 19 was also directed to a facility having at least one container in which is contained animal drinking water having therein the model biocidal composition for animals. However, since the Action indicates that Claims drawn to slaughter houses would be independent and distinct from the present claims and thus subject to restriction, claims to this aspect of Claims 19-25 are not presented herein. Applicants reserve the right to present such claims in another application.

The rejection of Claims 1-25 under 35 USC 103(a) on Dallmier et al. U.S. 5,795, 487 in view of Mora et al. '82, and Worley U.S. 4,767,542, and Padilla GB 1,139,188 is deemed inapplicable to the claims now in the case. None of the cited references teaches or suggests the use of 1,3-dibromo-5,5-dialkylhydantoin in drinking water for animals in order to reduce fecal contamination or the like. As shown, for example, by the test results given in Applicants Table 11 on page 33, DBDMH was shown to be far more effective than a number of other biocides for reducing fecal bacteria when used in drinking water provided to the test animals (broiler chicks). In fact, despite the good effectiveness of N,N'-bromochlorodimethylhydantoin, 1,3-dibromo-5,5-dimethylhydantoin (DBDMH) of the present claims was far superior. There is nothing in any of the references to suggest that in live animals, fecal bacterial contamination could be more effectively reduced by adding to the animal drinking water a 1,3-dibromo-5,5-dialkylhydantoin as compared to other biocides including an N,N'-bromochlorodimethylhydantoin, the hydantoin referred to by Padilla. Since the primary reference does not even deal with any kind of hydantoin compound, muchless reduction of fecal contamination in an animal, the applied secondary references when combined with Dallmier completely rewrite practically everything that is in Dallmier. There is no suggestion, let alone motivation, in any of the references to modify the teachings of Dallmier. In addition, it is well settled that in rendering a 103 rejection it is impermissible to pick and choose portions from different references in order to reconstruct a claimed invention using the Applicants disclosure as the blueprint. See for example *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) which states:

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." [*In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992, quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)].

See also, *ACS Hospital Systems, Inc. v Montefiore Hospital* 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984) which states:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teachings or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.

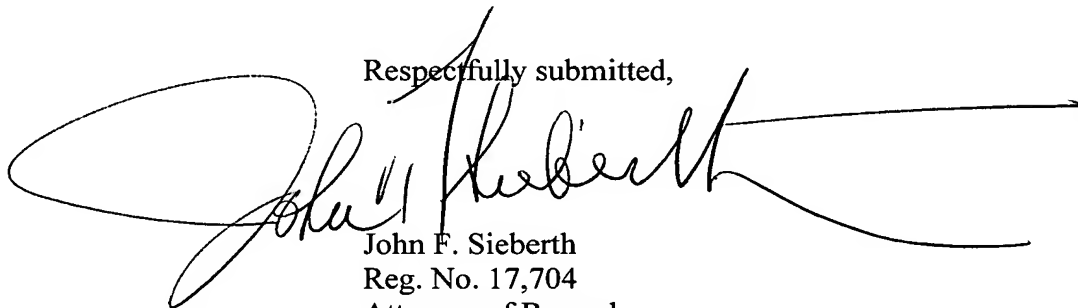
The only references to hydantoin compounds in the applied references are in Worley U.S. 4,767,542 at the top of Column 5 and in Padilla GB 1,139,188. However, Worley does not teach use of any 1,3-dibromo-5,5-dialkylhydantoin for any purpose. Moreover, Worley is concerned with disinfecting water itself containing undesired microorganisms and for this purpose, Worley must use an N,N'-dihalo-2-imidazolidinone as a principal disinfecting component and the reference to N,N'-dihalodimethylhydantoin at the top of Column 5 merely indicates that such a component might be used along with the N,N'-dihalo-2-imidazolidinone for killing microorganisms in water. This is not a suggestion to employ one or more 1,3-dibromo-5,5-dialkylhydantoins in animal drinking water so that fecal contamination in an animal can be effectively reduced.

Padilla GB 1,139,188 is concerned exclusively with 1-bromo-3-chloro-5,5-dimethylhydantoin. As noted above, Applicants have shown for example in Table 11 that the 1,3-dibromo-5,5-dialkylhydantoin(s) of the present claims are far more effective than even N,N'-bromochloro-5,5-dimethylhydantoin (BCDMH) and there is nothing in Padilla to suggest this. Indeed if anything, Padilla would motivate one to be entirely satisfied with BCDMH for the uses described therein.

We respectfully disagree with the contention of the paragraph bridging pages 3 and 4 of the Action. It is there stated that Applicant has not provided any objective evidence of criticality, non-obviousness, or unexpected results. As pointed out above, the extensive data presented in the present specification including, e.g., Table 11, clearly bring out the eminent superiority of the presently-claimed subject matter as compared to BCDMH, the material referred to by Padilla and Worley.

Since the references themselves fail to provide motivation to use any 1,3-dibromo-5,5-dialkylhydantoin in accordance with the present claims, it is felt that on reconsideration the rejection on Dallmier in view of Mora, Worley, and Padilla is inapplicable and should be withdrawn. Accordingly, favorable action on the claims now in the case is solicited.

Respectfully submitted,

A large, stylized handwritten signature in black ink, appearing to read "John F. Sieberth".

John F. Sieberth
Reg. No. 17,704
Attorney of Record

Telephone: (225) 291-4600
Facsimile: (225) 291-4606

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited on the date shown below with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

9-7-04

Date

A handwritten signature in black ink, appearing to read "Deborah A. Brouillette".

Deborah A. Brouillette